

REMARKS

This application has been reviewed in light of the Office Action dated June 15, 2004. Claims 1-11, 19-30, 32-40, and 48-56 are pending in this application. Claims 1-25, 32, 33, and 48-53 have been amended to define still more clearly what Applicants regards as their invention. Claims 1, 19, 25, 32, 33, and 48 are in independent form. Favorable reconsideration is requested.

The Office Action rejected Claims 1-11, 19-30, 32-40, and 48-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,567,800 (Barrera et al.) in view of the cited Ernst article, "Using Netscape", 1995 Que Corporation, pages 56, 57, and 73-82 ("Ernst").

Applicants submit that amended independent Claims 1, 19, 25, 32, 33, and 48, together with the remaining claims dependent thereon, are patentably distinct from the proposed combination of the cited prior art at least for the following reasons.

The aspect of the present invention set forth in Claim 1 is a method of presenting search results obtained from a search conducted over a computer network, the search being performed using searching criteria and returning information including a plurality of network locations. The method includes the steps of storing document data associated with and including the plurality of network locations, extracting stored document data associated with a first one of the network locations, examining the extracted data to identify therein the searching criteria to provide at least one specific location within the extracted data of the first network location of the searching criteria, using the one specific location to identify from the extracted data specific data including at least the searching criteria, formatting the specific data into a printable document, and repeating the extracting, examining, using, and formatting steps for each remaining network location in

54. (Previously Presented) A computer network browsing application comprising code operable to perform the method of claim 1 or claim 19.

55. (Previously Presented) A document formed according to the method of claim 1 or claim 19.

56. (Original) Apparatus configured to form a printable document according to claim 55.

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which the formatting step incorporates the formatted data of the remaining network location to the printable document.

Among other important features of Claim 1 are before the execution of the extracting through repeating steps recited in Claim 1, storing document data associated with and including the plurality of network locations. Support in the specification for the storage feature can be found at least at page 18, line 5.<sup>1</sup>

The method having the features recited in Claim 1 is premised on document data, which is obtained in advance of document formation, and stored in memory. In the method, using the results of the search, all the data relating to the network locations identified in the search result is downloaded (see Fig. 4). The downloaded data is then reviewed to identify instances of the specific search criteria which was used to create the search result. Thereafter, and only where such instances of the search criteria are expressly identified in the downloaded document data, is a printable document formatted for reproduction to the user.

Barrera et al., as understood by Applicants, relates to a system and method for searching information stored on a network. Ernst, as understood by Applicants, relates to Netscape, its features, and how to use it. Applicants submit that the steps recited in Claim 1 are not those associated with the production of the search result as in the case of Barrera et al. or other traditional search engines such as Yahoo® and Google™. As previously submitted, the method in Claim 1 operates on the search result to facilitate better provision of search results to the user. In those instances where the searching criteria

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<sup>1/</sup>(It is to be understood, of course, that the scope of the claims is not limited to the details of this embodiment.)

is not identified in the document data at the relevant network location, document data relating to the network location will not be, according to the method in Claim 1, presented to the user in the printable document. Such, for example, will apply to metadata associated in the HTML description of a web page, but does not appear as part of the "document data" displayed to the user when the web page is accessed.

The Office Action states in the middle of page 3 that "... Barrera teaches an embodiment whereby a search engine's query results include either the search term itself within each result (i.e. AT & T) or as close a match as possible (i.e., AT+T) (see Figure 4) providing the claimed equivalent of inclusion of 'search criteria' within the claimed 'formatted specific data.'" Applicants submit that even if Barrera et al. would teach or suggest the search results shown in Figure 4, nothing has been found in Figure 4, or any other section of Barrera et al., that would teach or suggest storing document data associated with and including the plurality of network locations, as recited in Claim 1.

In addition, Applicants note that the MPEP, Section 2143.01, requires that the prior art reference teach or suggest the desirability of the claimed invention. Applicants submit, however, that nothing has been adduced in the Office Action that would indicate that Barrera et al. and Ernst, when taken separately or in any proper combination, would teach or suggest the desirability of the method recited in Claim 1, including the step of storing document data associated with and including the plurality of network locations as recited in Claim 1.

Moreover, Applicants note that the MPEP, Section 2141.02, states that the prior art reference must be considered in its entirety (as a whole) including those portions that would teach away from the claimed invention. In this regard, Applicants have, in previous submissions to the Patent Office, clearly identified those instances where Barrera

et al. teaches away from the method recited in Claim 1. In addition, Applicants submit that in Barrera et al., Figure 4 shows an interface and a keyword search request to a prior art embodiment of a content search engine. In regard to Figure 4, the Barrera et al. specification at column 2, lines 25-28, states that "[i]n AltaVista™, a user submits a keyword search. FIG. 4 shows the AltaVista™ interface in which a user has submitted a keyword search request for the term AT&T 401." Applicants submit, however, that nothing in this section, or any other section of Barrera et al., has been found that would teach or suggest storing document data associated with and including the plurality of network locations, as recited in Claim 1.

Accordingly, Applicants submit that at least for these reasons, Claim 1 is patentable over Barrera et al. and Ernst, when taken separately or in any proper combination (assuming such combination would even be permissible).

Independent Claims 25 and 33 are apparatus and computer memory medium claims, respectively, that correspond to method Claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 1.

The aspect of the present invention set forth in Claim 19 is a method of formatting an electronic document intended for reproduction by printing. The method includes the steps of obtaining, from a searching process, location information within a computer network of at least one search result returned by the searching process, using the location information to fetch and store document data from the computer network relating to each search result, the document data including searching criteria used to instigate the searching process, and formatting the stored data including the searching criteria into a printable electronic document.

Among other important features of Claim 19 are the steps of using the location information to fetch and store document data, and formatting the stored data. Similar to Claim 1, the changes to Claim 19 relate to the storage of document data obtained from the network location using the location information obtained from the searching process. The method having the features recited in Claim 19 is performed distinct from the actual searching process and makes use of the information returned thereby, but separately obtains the document data available at each of the network locations returned by the search in order to format that document data which includes actual searching criteria into the printable electronic document.

Applicants submit that nothing has been found in Barrera et al. and Ernst, when taken separately or in any proper combination (assuming such combination would even be permissible) that would teach or suggest the steps of using the location information to fetch and store document data, and formatting the stored data, as recited in Claim 19.

Independent Claims 32 and 48 are apparatus and computer memory medium claims, respectively, that correspond to method Claim 19, and are believed to be patentable for at least the same reasons as discussed above in connection with Claim 19.

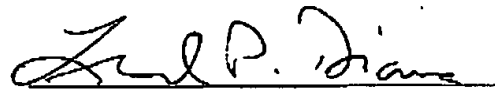
The other rejected claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicants' undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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